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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,217	02/13/2002	Pascal Nicolle	SCHN : 019	4817

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EXAMINER	
NAHAR, QAMRUN	

ART UNIT	PAPER NUMBER
2191	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/073,217	NICOLLE ET AL.	
	Examiner	Art Unit	
	Qamrun Nahar	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the amendment filed on 3/17/05.

2. The objection to the oath/declaration is withdrawn in view of applicant's submission of oath/declaration on 03/24/2005.

3. The objection to the abstract is withdrawn in view of applicant's amendment.

4. The objection to the disclosure is withdrawn in view of applicant's amendment.

5. The objections to the claims because of informalities are withdrawn in view of applicant's amendment.

6. The rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention to claims 1-12 is withdrawn in view of applicant's amendment.

7. Claims 1-12 have been amended.

8. Claims 13-14 have been added.

9. Claims 1-14 are pending.

10. Claims 9-10 stand finally rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. Claims 1-14 stand finally rejected under 35 U.S.C. 102(e) as being anticipated by Muenzel (US 2002/0004804 A1).

Response to Amendment

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 9-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 9, merely claimed as a program representing a computer listing *per se* (automation application program), that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical "thing" nor a statutory process, *as there are not "acts" being performed.* Such claimed programs do not define any structural and functional interrelationships between the program and other claimed aspects of the invention which permit the program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the program's functionality. In contrast, a claimed computer-readable medium encoded with a program defines structural and functional interrelationships between the program and the medium which permit the program's functionality to be realized, and is thus statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

It is suggested that claim 9 be amended to recite the claimed automation application program performing a function and/or step. That is, the claimed automation application program must recite actual function and/or step carried out when the automation application program is executed that results in a tangible result. Merely reciting the intended purpose for the automation application program is not sufficient.

As per claim 10, this claim fails to cure the deficiency of the above rejected non-statutory claim 9.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Muenzel (US 2002/0004804 A1).

Per Claim 1 (Amended):

The Muenzel publication discloses:

- a programming station for generating an automation application designed to be executed in an automation equipment, the programming station comprising: a memory for storing at least one description file, each description file describing part of an automation application program and expressed in a single, hierarchical and object-oriented language (pg. 3, par. 0027; and see Figure 1, item 26)

- a compression program stored in said memory for generating a file in a compacted format for each description file, said compression program comprising a stylesheet and a compaction algorithm, said stylesheet for generating a reduced file to be processed by said compaction algorithm for generation of a compacted file, wherein contents of the compacted file describe a part of an application program for execution; and a loading program for storing each compacted file in a memory located in an automation equipment (pg. 3, par. 0038 to pg. 4, par. 0040; and see Figure 2, item 64; the markup formatted form 64 is interpreted as a compacted format for each description file; the markup formatted form 64 is generated based on the XML schema, which is interpreted as the stylesheet.).

Per Claim 2 (Amended):

The Muenzel publication discloses:

- a decompression program for generating a description file in a single, hierarchical and object-oriented language describing part of an application program, from a compacted file stored in such an automation equipment memory (pg. 4, par. 0041).

Per Claim 3 (Amended):

The Muenzel publication discloses:

- wherein the single, hierarchical and object-oriented language is XML language (pg. 3, par. 0027).

Per Claim 4 (Amended):

The Muenzel publication discloses:

- wherein said memory is for storing a set of description files containing an application program description file, an application input-output description file, and an application data description file (pg. 2, par. 0012).

Per Claim 5 (Amended):

The Muenzel publication discloses:

- wherein the compression program and the decompression program are for being individually executed (pg. 3, par. 0038 to pg. 4, par. 0041).

Per Claim 6 (Amended):

The Muenzel publication discloses:

- wherein the compression program is for reducing a length of tags contained in a description file expressed in XML language by application of said stylesheet (pg. 4, par. 0042, lines 1-13).

Per Claim 7 (Amended):

The Muenzel publication discloses:

- wherein the decompression program is for executing a decompaction algorithm adapted to XML files and for recreating source tags contained in a description file expressed in XML language, by application of said stylesheet (pg. 4, par. 0042, lines 13-16).

Per Claim 8 (Amended):

The Muenzel publication discloses:

- an XML handler program stored in a non-volatile memory for communicating with a management module of a tree structure representative of an automation application program expressed in XML language, with a plurality of database managers, each manager being specific to part of an automation application program stored in one of a plurality of databases (pg. 5, par. 0055).

Per Claim 9 (Amended):

The Muenzel publication discloses:

- an automation equipment comprising a memory for containing an automation application program in a form of a binary file executable by the automation equipment, wherein the automation equipment is for storing the executable file in said memory, together with at least one file in compacted format output from at least one description file describing an

automation application program and expressed in a single, hierarchical and object-oriented language, said at least one compacted file formed by operation of a stylesheet and a compaction algorithm, the stylesheet for generating a reduced file for processing by the compaction algorithm for generation of the compacted file (pg. 3, par. 0027 and par. 0038; and see Figure 1, item 26; the markup formatted form 64 is interpreted as a compacted format for each description file; the markup formatted form 64 is generated based on the XML schema, which is interpreted as the stylesheet.).

Per Claim 10 (Amended):

The Muenzel publication discloses:

- **wherein the single, hierarchical and object-oriented language is XML language** (pg. 3, par. 0027).

Per Claim 11 (Amended):

The Muenzel publication discloses:

- **translation means for converting the at least one description file expressed in XML language into a binary file that can be executed by automation equipment** (pg. 3, par. 0038 to pg. 4, par. 0040; and see Figure 2, item 64).

Per Claim 12 (Amended):

The Muenzel publication discloses:

- means for decompressing a file in a compacted format to form a description file in XML language by using a specific stylesheet stored in said memory (pg. 4, par. 0041).

Per Claim 13 (New):

The Muenzel publication discloses:

- wherein said stylesheet is written in eXtensible Stylesheet language (XSL) (pg. 3, par. 0027).

Per Claim 14 (New):

The Muenzel publication discloses:

- wherein said stylesheet is written in eXtensible Stylesheet language (XSL) (pg. 3, par. 0027).

Response to Arguments

16. Applicant's arguments filed on 3/17/05 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

a) The Examiner asserts that Muenzel '804 discloses a compression program that generates a compacted file. Applicants, with respect, disagree. Muenzel '804 at Fig. 2 and related paragraphs 0038-0040 actually describes a converter 66 for converting binary format to formatted form 64 for subsequent viewing on a display device or printer, and optional transmission. Muenzel '804 says nothing about a compressed format, and even if the formatted form 64 shown in Muenzel '804, Fig. 2, were regarded to be comparable to applicants' reduced file, Muenzel '804 does not disclose or suggest (1) such file being a reduced file generated by use of a style sheet, or (2) such file being subsequently processed by a compaction algorithm to generate a compacted file, wherein contents of the compacted file describe part of the application program for execution, as recited in applicants' independent claims.

For the foregoing reasons, Muenzel '804 fails to disclose all elements of applicants' claimed invention, and therefore is not a proper basis for rejection under §102. Claims 2-8 and 13, which depend from claim 1, are allowable for the same reasons that claim 1 is allowable, and claims 10-12 and 14, which depend from claim 9, are allowable for the same reasons that claim 9 is allowable. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Examiner's response:

a) Examiner strongly disagrees with applicant's assertion that Muenzel fails to disclose the claimed limitations recited in claims 1-14. Muenzel clearly shows each and every limitation in claims 1-14.

Muenzel teaches a compression program stored in said memory for generating a file in a compacted format for each description file, said compression program comprising a stylesheet and a compaction algorithm, said stylesheet for generating a reduced file to be processed by said compaction algorithm for generation of a compacted file, wherein contents of the compacted file describe a part of an application program for execution; and a loading program for storing each compacted file in a memory located in an automation equipment (pg. 3, par. 0038 to pg. 4, par. 0040; and see Figure 2, item 64; the markup formatted form 64 is interpreted as a compacted format for each description file; the markup formatted form 64 is generated based on the XML schema, which is interpreted as the stylesheet.).

In addition, see the rejection above in paragraph 15 for rejection to claims 1-14.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WEI Y. ZHEN
PRIMARY EXAMINER

QN
June 8, 2005